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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket: ATM-2215-2

Appellants : Wilfried JUD et al.

Examiner : Monique Jackson

Serial No. : 10/083,110

Art Unit: 1773

Filed : 06/14/2001

For : STERILIZIBLE COMPOSITE FILM

TRANSMITTAL LETTER

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached hereto, please find:

(1) A Transmittal Letter

(2) A Reply Brief (in triplicate) in response to Examiner's Answer dated November 3, 2005

(3) A Return Receipt Postcard

If any additional fees are due upon the filing of this paper, please charge Deposit Account No. 06-1110. A duplicate of this Transmittal Letter is attached for such purpose.

Respectfully submitted,

Dec. 17, 2005
Date

Virgil H. Marsh
Reg. No.: 23,083

Fisher, Christen & Sabol
Suite 1108
1725 K Street, N.W.
Washington, D.C. 20006
Tel.: 202 659-2000
Fax: 202 659-2015

CERTIFICATE OF MAILING

I hereby certify that this correspondence of is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 19, 2005.

Leslie Stepney

FISHER, CHRISTEN & SABOL
1725 Street, N.W., Suite 1108
Washington, D.C. 20006

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REPLY BRIEF

Mail Stop Appeal Brief
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Sir:

Appellants' Appeal Brief still shows that the two anticipation rejections are in error and that the Examiner's Answer does not revive the anticipation rejections.

Besides the errors in and unsustainability of the four obviousness rejections, as shown in appellants' Appeal Brief, the four obviousness rejections are defective on their face and for failure to follow Patent Office policy and the requirements of the Supreme Court's Graham decision [i.e., 383 U.S.1, 148 USPQ 459 (1966)].

Section 2141 of the M.P.E.P. (Rev. 2) states:

> "Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated therein as a background for determining obviousness are as follows:
>
> (A) Determining the scope and contents of the prior art;
>
> (B) Ascertaining the differences between the prior art and the claims in issue;

(C) Resolving the level of ordinary skill in the pertinent art; and

(D) Evaluating evidence of secondary considerations."

[Emphasis Supplied]

Nowhere has the Examiner factually determined in the record the level of ordinary skill in the art. Accordingly, the Examiner has not made a valid obviousness rejection or a valid factual showing of prima facie obviousness.

The Board's (nonprecedential) decision of Ex parte Leu et al. states:

> "Rejections based on § 103(a) must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the Appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Productions Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988)," [Emphasis supplied] [Page 7, lines 9 to 15].

Section 2141.03 of the M.P.E.P. (Rev. 2) states:

> "'The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.' *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied,* 464 U.S. 1043 (1984).

Since the Examiner has not factually determined in the record the level of ordinary skill in the art, there cannot be a prima facie showing of obviousness. The burden of proof is still on the Examiner. Section 2144.08, II of the M.P.E.P. states:

> "A proper obviousness analysis involves a three-step process. First, Office personnel should establish a *prima facie* case

of unpatentability considering the factors set out by the Supreme Court in *Graham v. John Deere*. See, e.g., *In re Bell*, 991 F.2d 781, 783 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ('The PTO bears the burden of establishing a case of *prima facie* obviousness.'); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *Graham v. John Deere Co.*, 383 U.S. 1; 17-18 (1966), requires that to make out a case of obviousness, one must:

(A) determine the scope and contents of the prior art;

(B) ascertain the differences between the prior art and the claims in issue;

(C) determine the level of skill in the pertinent art; and

(D) evaluate any evidence of secondary considerations. If a *prima facie* case is established, the burden shifts to applicant to come forward with rebuttal evidence or argument to overcome the *prima facie* case." [Emphasis Supplied]

Regarding the third ground of rejection, the Examiner's Answer states:

"..., one skilled in the art would be motivated to...." [Page 6, line 16]

"...one skilled in the art at the time of the invention would be motivated to...."

One skilled in the art has nothing to do with Section 103(a) so this obviousness rejection is defective on its face. The third ground of rejection is clearly in error and defective.

The Board's (nonprecedential) decision of Ex parte Yim et al., (Appeal No. 2005-2013), states:

"To hold an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the reference teachings and combine them in a way that would produce the claimed invention." [Page 3, lines 16 to 19]

The Examiner has not factually determined in the record the ordinary level of skill in the art so the Examiner does not know who is, or anything about, one

ordinarily skilled in the art. Accordingly, even where one ordinarily skilled in the art is asserted by the Examiner to have motivation, the Examiner's position is clearly defective because the Examiner does not know about one ordinarily skilled in art. The Examiner has not factually established in the record any *prima facie* showing of obviousness of appellants' claimed invention.

> Regarding the fourth ground of rejection, the Examiner's Answer states:
>
> "...one skilled in the art at the time of the invention would have been motivated to ...." [Page 7, lines 18 and 19]

This obviousness rejection is defective on its face because one skilled in the art has nothing to do with Section 103(a).

> Regarding the fifth ground of rejection, the Examiner's Answer states:
>
> "..., one skilled in the art would have been motivated to...." [Page 8, line 20]

This obviousness rejection is defective on its face because one skilled in the art has nothing to do with Section 103(a).

> Regarding the sixth ground of rejection, the Examiner's Answer states:
>
> "...that one skilled in the art would be directed to Appellants' invention...."
>
> [Page 13, line 17]

This obviousness rejection is defective on its face because one skilled in the art has nothing to do with Section 103(a).

Appellants request that the Board reverse the rejections made by the Examiner.

Three executed copies of this Reply Brief are filed.

Respectfully submitted,

Dec. 17, 2005
Date

Virgil H. Marsh
Registration No. 23,083

Fisher, Christen & Sabol
1725 K Street, N.W.
Suite 1108
Washington, D.C. 20006
Tel: 202-659-2000
Fax: 202-659-2015

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FISHER, CHRISTEN & SABOL
1725 Street, N.W., Suite 1108
Washington, D.C. 20006